

**Remarks**

This Reply is in response to the Office Action mailed August 3, 2005. Claims 41-52 were pending in the application. No claims are amended or canceled. Thus, claims 41-52 are pending for reconsideration at this time.

Applicants thank the Examiner for allowing claims 42-46 and 48-52.

In the Office Action, claims 41 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Patent No. 6,706,016 to Cory et al. Applicants respectfully traverse these rejections for at least the following reasons.

The present application is a divisional of U.S. Application No. 9/989,206 which issued as U.S. Patent No. 6,706,016 ("the '016 patent"). A Requirement for Restriction was issued on September 25, 2002 for Application No. 9/989,206 in which the Examiner stated that claims "comprising marks" were a patentably distinct species. Applicants timely traversed the restriction in a reply dated October 9, 2002, but the Examiner deemed the restriction proper and final and withdrew claims 10-15, 27, and 30-34 in an Office Action mailed December 12, 2002. For the convenience of the Examiner, a copy of the Requirement for Restriction and the Office Action of December 12, 2002 affirming the restriction from the '016 patent are attached. Before issuance of the '016 patent, Applicants timely filed the present divisional application to pursue the subject matter of the non-elected claims. Specifically, claims 41 and 47 recite the same subject matter as the non-elected claims 10 and 27 of Application No. 9/989,206, respectively, redrafted in independent form.

Applicants respectfully direct the Examiner's attention to 35 U.S.C. § 121 and MPEP 804.01 regarding the rejection of a divisional application as obvious in view of a parent application. As explained in that section of the MPEP, 35 U.S.C. § 121 prohibits the rejection of a divisional application based upon its parent as part of an obviousness-type double patenting rejection. The line of demarcation between the independent and distinct inventions identified by the Examiner in the Requirement for Restriction, namely "marks," is maintained, because claims

41 and 47 of the present application recite identical subject matter to the restricted and withdrawn claims and claims 1 and 11 of the '016 patent do not recite "marks." Therefore, Applicants respectfully submit that the rejections of claims 41 and 47 are improper, and respectfully request withdrawal of the obviousness-type double patenting rejection of claims 41 and 47.

**Conclusion**

In view of the above remarks, Applicants respectfully request that all rejections be withdrawn and that a notice of allowance be forthcoming. The Examiner is invited to contact the undersigned for any reason related to the advancement of this case.

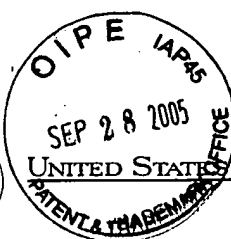
The Commissioner is authorized to credit any over payment or charge any deficient to deposit account number 08-1641.

Respectfully submitted,

Date: September 28, 2005

By: Robert M. Hansen #43,656  
for Johnny A. Kumar  
Attorney for Applicant  
Registration No. 34,649

**Address all correspondence to:**  
HELLER EHRMAN LLP  
1717 Rhode Island Ave., NW  
Washington, D.C. 20036  
Telephone: 202-912-2000  
Facsimile: 202-912-2020  
Customer Number: 26633



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,206	11/21/2001	Joan M. Cory	54644-017	9309

7590

09/25/2002

McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

KENNEDY, SHARON E

ART UNIT

PAPER NUMBER

3763

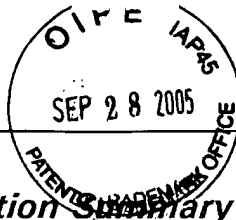
DATE MAILED: 09/25/2002

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SEP 30 2002

McDermott, Will &amp; Emery



# Office Action Summary

Application No.

09/989,206

Applicant(s)

Cory et al.

Examiner

Sharon Kennedy

Art Unit

3763



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-40 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Election/Restriction*

1. Claims 1-40 are generic to a plurality of disclosed patentably distinct species comprising various embodiments for determining the depth of a needle for a nerve stimulator. **Specifically, select one specie from the following list:**

- ✧ Specie 1. Figures 3a-3c, comprising a linear resistance coating;
- Specie 2. Figure 5, comprising marks;
- Specie 3. Figure 6, comprising a strip of resistance material;
- Specie 4. Figures 8-9, comprising an optical control mechanism.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

3. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. A telephone call was made to Lawrence Cullen on September 23, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR

1.143). **In addition, applicant should provide a listing of all claims readable upon the elected specie.**

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 305-0154.

September 23, 2002

  
Sharon Kennedy  
Primary Examiner



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,206	11/21/2001	Joan M. Cory	54644-017	9309

7590 12/12/2002  
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EXAMINER

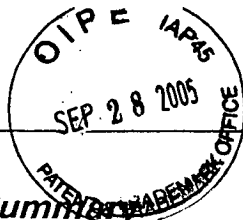
KENNEDY, SHARON E

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/989,206

Applicant(s)

Cory et al.

Examiner

Sharon Kennedy

Art Unit

3763



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

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## Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) 10-15, 27, and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 16-24, 35, and 36 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 25, 26, 28, 29, and 37-40 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
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a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
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- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:



### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

#### ***Election/Restriction***

2. Applicant's election with traverse of Species 1 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that four species are not an unreasonable number of embodiments in an application. This is not found persuasive because the subject matter which applicant presents is complicated, each specie requires an independent search to locate secondary references since the species do not have similar structures (of depth determination), and applicant should note that the method and apparatus claims were not restricted. Further, it is likely that an appropriate generic claim could be drafted to encompass at least some of the species.
3. The requirement is still deemed proper and is therefore made FINAL.
4. Claims 10-15, 27, 30-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

#### ***Claim Rejections - 35 USC § 102***

5. Claims 1-3, 5-7, 16-19, 21-24, 35 and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Griffith et al., US 5,853,373. Regarding claims drafted to changing current amplitudes, frequency, etc., and the controller, note the application of current pulses discussed by Griffith in column 3, lines 25-56, and column 8, lines 1-36. Regarding claims 2-3, 18 and 19, see column 7, lines 33-36 of Griffith for infusion of medicaments through the needle. Regarding

claims 16 and 35, note the disclosure of the polyimide tube 28 which serves as an insulator.

Regarding claim 36 and operating the nerve stimulator with one hand, see column 3, lines 11-17 of Griffith which discloses that feature.

***Claim Rejections - 35 USC § 103***

6. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffith, US '373. Griffith is silent with regards to the manual switches controlling the device. However, the pressure sensitive switches claimed are notoriously old and already used in alarm clocks, microwaves, telephones, DVDs, etc. Accordingly, it would be obvious to one of ordinary skill in the art to incorporate them into the Griffith device for ease of handling.

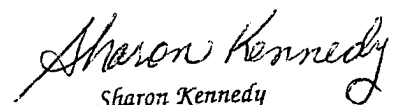
***Allowable Subject Matter***

7. Claims 8, 9, 25, 26, 28, 29, 37-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The claims are directed to the electrically resistive layer in combination with the electrical trace to determine the depth of penetration of the needle, or the steps of calculating the depth of the needle using the electrically resistive layer. This manner of determining the depth of a medical instrument is not found in the prior art. Accordingly, the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 305-0154.

December 6, 2002

  
Sharon Kennedy  
Primary Examiner